



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<i>In re</i> the application of	)	
Kenji FUKUSAWA	)	Art Unit: 2628
Application No. 10/072,266	)	Examiner: A. Caschera
Filed: February 5, 2002	)	Atty. Docket No. MIPFP003
For: OUTPUT IMAGE ADJUSTMENT	)	Date: September 14, 2007
FOR GRAPHICS FILES	)	Confirmation No. 2068

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 14, 2007.

Signed: \_\_\_\_\_

Peter B. Martine

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection set forth in the Final Office Action dated June 14, 2007. This request is being filed concurrently with a Notice of Appeal, as well as an Amendment Under 37 C.F.R. § 1.116 in which claim 46 has been canceled.

Claims 1-10, 12-38, 43, and 45 are pending in the subject application (upon cancellation of claim 46). Claims 1-3, 9, 10, 12-16, 22-30, 33-35, 38, 43, and 45 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ishii et al.* (U.S. Patent No. 5,982,416) in view of *Ohta* (U.S. Patent No. 6,108,008). Claims 4-8, 17-21, 31, 32, 36, and 37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ishii et al.* in view of *Ohta*, and further in view of *Kohler et al.* (U.S. Patent No. 5,646,752). As will be explained in more detail in the Argument section set forth below, the obviousness rejection is improper because the Examiner has effectively omitted several features required to establish a *prima facie* case of obviousness by either misinterpreting the claimed subject matter or mischaracterizing the prior art relative to the claimed subject matter.

## **ARGUMENT**

### **Argument No. 1: The *Ishii et al.* and *Ohta* References Distinguished**

Applicant distinguished the claimed subject matter from the subject matter shown in the *Ishii et al.* reference in the Amendment filed on February 23, 2007 (and received in the PTO on February 27, 2007) (see pages 14 and 15).

The *Ohta* reference discloses a color matching-related technique in which an input profile and an output profile are stored in host equipment 100. *Ohta* uses a printer condition setting means 9 to set output profiles, so as to produce a desired color in accordance with parameters faithful to the characteristics of an output device. While *Ohta*'s host equipment sets and reads the output profile according to the printer condition, the claimed configuration generates output control data and image data in a file. In this regard, the claimed subject matter is distinguishable from *Ohta*.

The claimed subject matter uses a single image file to enable multiple output devices with different reproduction characteristics to respectively achieve appropriate color reproduction. The *Ohta* reference, on the other hand, needs to prepare different output profiles for multiple output devices with different image reproduction characteristics (in addition, input profiles and, naturally, image files are necessary), and this results in a complicated system structure. In contrast, the claimed subject matter uses a single image file and enables multiple output devices with different image reproduction characteristics to respectively achieve appropriate color reproduction, so the claimed subject matter has a much simpler configuration.

### **Argument No. 2: Independent Claims 1 and 12-14**

Claim 1 defines an image data generating device including an "output control data acquisition mechanism" (and claims 12-14 specify a similar feature or functionality). As will be explained in more detail below, neither the *Ishii et al.* reference nor the *Ohta* reference discloses or suggests the claimed "output control data acquisition mechanism."

In support of the obviousness rejection, the Examiner states that *Ishii et al.*'s CMS process unit acts as the functional equivalent of the claimed output control data acquisition mechanism (see the Final Office Action at page 3). In the case of *Ishii et al.*, the CMS process unit is not included in image pickup unit 11 but rather in host computer 10. The claimed configuration associates image data with output control data upon image shooting, so as to solve the problems inherent in the image data generating device, which is physically

separate from the image processing device. Whatever processing the host computer 10, which is equivalent to the image processing device, carries out, it is not proper to use the CMS process unit included therein as the basis for rejecting the claimed subject matter.

In the Final Office Action, the Examiner also states that the *Ishii et al.* reference does not explicitly disclose outputting output control data designating image processing conditions to be carried out by each of a plurality of output devices; however, in support of the obviousness rejection, the Examiner asserts that *Ohta* discloses an image processing apparatus able to faithfully reproduce a desired color under the output conditions of predetermined output means (see the Final Office Action at pages 3-4).

In response, Applicant notes that claim 1 is not directed toward an image *processing* device. In *Ohta*'s configuration, the host equipment sets the output profile according to the printer condition; however, this does not mean that the set output profile is output to the printer together with the target image data. In other words, *Ohta* merely discloses a technique for correcting an output profile in the existing color matching field. Further, *Ohta* fails to disclose or suggest using an image pickup device to associate target image data with output control data tailored for a target output device.

In summary, both the *Ishii et al.* and *Ohta* references relate to a color matching technique, and each of these references discloses and suggests only a technique for a host (i.e., an image processing device). The combination of the *Ishii et al.* and *Ohta* references is therefore not believed to form an appropriate basis for rejecting claims directed toward an image data *generating* device.

Thus, for at least the foregoing reasons, the combination of *Ishii et al.* in view of *Ohta* would not have resulted in an image data generating device having the features specified in claim 1 (or the features specified in claims 12-14, which also relate to an image data generating device or the functionality of the image data generating device). Accordingly, the combination of *Ishii et al.* in view of *Ohta* does not raise a *prima facie* case of obviousness against independent claims 1 and 12-14.

### **Argument No. 3: Independent Claims 25-28**

Independent claim 25 defines an image data generating device that includes essentially the same "output control data acquisition mechanism" as specified in claim 1, except that claim 25 further specifies the feature of identifying information for identifying respective output devices (and claims 26-28 specify the same features or functionality). Accordingly, the combination of *Ishii et al.* in view of *Ohta* does not raise a *prima facie* case

of obviousness against independent claims 25-28 for at least the same reasons discussed above with regard to claims 1 and 12-14.

**Argument No. 4: Independent Claim 45**

Independent claim 45 defines an image data generating device that differs from that defined in claim 1 in that claim 45 is directed toward a single output device. Nevertheless, the arguments set forth above with regard to claim 1 also apply to claim 45. Accordingly, the combination of *Ishii et al.* in view of *Ohta* does not raise a *prima facie* case of obviousness against independent claim 45.

**Argument No. 5: Independent Claims 29, 33, 34, and 38**

Independent claim 29 defines an output control device for outputting image data to one or more of a plurality of output devices using image data and output control data designating image processing conditions to be carried out by each of the plurality of output devices and designating output conditions for each of the plurality of output devices, wherein the output control data and the image data are contained in a file by an image generating device (and claims 33, 34, and 38 specify the same features or functionality). For the claimed subject matter, it is not the case that a host adjusts the image adjustment conditions through input and output profiles as shown in the prior art. Instead, the claimed configuration allows an image processing device to carry out output control, as a slave of the image data generating device, in accordance with the output conditions designated by the image data generating device. As such, the combination of the *Ishii et al.* reference and the *Ohta* reference would not have suggested to one having ordinary skill in the art the claimed configuration. Accordingly, the combination of *Ishii et al.* in view of *Ohta* does not raise a *prima facie* case of obviousness against independent claims 29, 33, 34, and 38.

**Conclusion**

For the reasons set forth above, the combination of *Ishii et al.* in view of *Ohta* does not disclose or suggest each and every feature of the subject matter defined in claims 1-10, 12-38, 43, and 45. It is axiomatic that the prior art must disclose or suggest each and every feature of the claimed subject matter to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Accordingly, the combination of *Ishii et al.* in view of *Ohta* does not raise a *prima facie* case of obviousness against the claimed subject matter.

In view of the foregoing, Applicants respectfully submit that claims 1-10, 12-38, 43, and 45 are in condition for allowance. Accordingly, a notice of allowance is respectfully

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requested. In the event a telephone conversation would expedite the prosecution of this application, Applicants' undersigned representative may be reached at **(408) 749-6902**. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP003).

Respectfully submitted,  
MARTINE PENILLA & GENCARELLA, LLP

A handwritten signature in black ink, appearing to read "P. B. Martine", with a stylized flourish at the end.

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